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### REMARKS

The Applicants wish to thank the Examiner for his courtesy during a telephonic interview on June 11, 2004. The Applicants also wish to thank the Examiner for his consideration of their previous remarks and for the removal of the rejections made in points 9-20 of the previous office action.

Claims 1-2, 8-35, and 37-70 are pending. Claims 1, 9, 11-12, 29, 34-35, 37, 39-40, 44, 46-47, and 69-70 have been amended in order to eliminate non-elected subject matter. Claims 2, 8, 13-14, 38, 42-43, and 49 have been cancelled as repetitive after amending the other claims to eliminate non-elected subject matter. The Applicants have also amended claim 34 to clarify the term "cardiovascular diseases" by adding the term "associated with increased insulin levels." This change does not alter the scope of the claim, as the association with increased insulin levels is clear from original claim 34 and from the specification at p. 113, lines 16-19.

The Applicants reserve the right to pursue non-elected subject matter in future applications and to file continuing applications regardless of whether or not the restriction is appropriate.

Claims 1-2, 8-17, 19, 26, 30, 35, 37-52, 54, 61 and 65 stand rejected. Claims 18, 20-25, 27-29, 31-34, 53, 55-60, 62-64, and 66-70 are objected to.

None of the above changes raise any issue of patentability. Both before and after the above changes, the invention was described in full, clear, concise, and exact terms and met all conditions for patentability under 35 USC 101 *et seq.* The scope of the claims of any resulting patent (and any and all limitations in any of said claims) shall not under any circumstances be limited to their literal terms, but are intended to embrace all equivalents. Accordingly, under no circumstances whatsoever may these claims be interpreted as:

1. having been altered in any way for any reason related to patentability;
2. having been narrowed;
3. a concession that the invention as patented does not reach as far as the original, unamended claim;
4. a surrender of any subject matter as a condition of receiving a patent; and/or,
5. estopping applicants from asserting infringement against every equivalent, whether now known or later developed, foreseen or unforeseen.

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Applicants also emphasize that the decision to address the Examiner's suggestions via claim amendment with the understandings set forth above is not in any way intended to avoid the "gatekeeping" role of the PTO with regard to the examination and issuance of valid patents for patentable inventions.

#### **I. THE RESTRICTION/ELECTION REQUIREMENT (POINT 3)**

The Examiner objects to claims 1-2, 8-29, 31-35, and 37-70 as containing non-elected subject matter.

Claims 1, 9, 11-12, 29, 34-35, 37, 39-40, 44, 46-47, and 69-70 have been amended in order to eliminate non-elected subject matter. Claims 2, 8, 13-14, 38, 42-43, and 49 have been cancelled as repetitive after amending the other claims to eliminate non-elected subject matter. The Applicants reserve the right to pursue non-elected subject matter in future applications and to file continuing applications.

Therefore, the Applicants believe that claims 1-2, 8-29, 31-35, and 37-70 are directed to elected subject matter only.

#### **II. TITLE (POINT 4)**

The Examiner objects to the title saying that after the election the title of the invention is not descriptive. The Examiner suggests replacing the phrase "Novel Aryl" with "Phenyl Phosphonate."

In order to advance the prosecution of this Application, the Applicants have amended the title to "Phenyl Phosphonate Fructose-1,6-Bisphosphatase Inhibitors." According to established case law, the title has no bearing on claim interpretation. Thus, Applicants amendment to the title is not a concession that the claims have been narrowed. The Applicants note that they reserve the right to prosecute the full scope of any cancelled or amended claims including, but not limited to, non-elected subject matter in future applications.

#### **III. CLAIM OBJECTIONS (POINT 5)**

The Examiner objects to claims 8 and 43 as lacking periods.

Claims 8 and 43 have been cancelled as repetitive after amending the other claims to eliminate non-elected subject matter. Therefore, the Applicants believe that this objection is moot.

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Patent  
45198.00042.RCE**IV. THE 35 U.S.C. § 112, SECOND PARAGRAPH REJECTION (POINT 6)**

The Examiner has newly rejected claims 1-2, 8-17, 19, 26, 30, 35, 37-52, 54, 61 and 65 as indefinite

The Applicants respectfully traverse this rejection.

The Examiner argues:

The phrase "heterocyclic alkyl" is found in claims 1 and 37. It is neither a recognized term of art nor defined in the specification. There is no such thing. Is it an alkyl substituted by a heterocycle, e.g. pyridyl-methyl? A cycloalkyl interrupted by a heteroatom, such as piperidinyl? A cycloalkyl substituted by a heteroatom, e.g. chlorocyclohexyl? Whatever choice is selected must be supported by the specification. (Office Action p. 5)

The Applicants do not agree that the term is not a recognized term of art, however, as discussed during the Telephonic Interview on June 11, 2004 and acknowledged by the Examiner at that time, the term "heterocyclic alkyl" is defined in the specification at page 7, lines 12-17 as follows:

The term "heterocyclic" and "heterocyclic alkyl" refer to cyclic groups of 3 to 6 atoms, or 3 to 10 atoms, containing at least one heteroatom. In one aspect, these groups contain 1 to 3 heteroatoms. Suitable heteroatoms include oxygen, sulfur, and nitrogen. Heterocyclic groups may be attached through a nitrogen or through a carbon atom in the ring. Suitable heterocyclic groups include pyrrolidinyl, morpholino, morpholinoethyl, and pyridyl. Such groups may be substituted.

Therefore, a person of ordinary skill in the art would clearly understand what is meant by the term "heterocyclic alkyl." The Applicants respectfully submit that Claims 1-2, 8-17, 19, 26, 30, 35, 37-52, 54, 61 and 65 are definite and request withdrawal of the rejection.

**V. THE 35 U.S.C. § 112, FIRST PARAGRAPH REJECTION (POINT 7)**

The Examiner has newly rejected claims 1-2, 8-17, 19, 26, 30, 35, 37-52, 54, 61 and 65 for failing to comply with the written description requirement.

The Applicants respectfully traverse this rejection.

The Examiner says that "The phrase 'heterocyclic alkyl' was not contained in the specification as filed." (Office Action p. 5)

As discussed during the Telephonic Interview on June 11, 2004, and acknowledged by the Examiner at that time, the term "heterocyclic alkyl" is defined in the specification at page 7, lines 12-17 as follows:

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The term "heterocyclic" and "heterocyclic alkyl" refer to cyclic groups of 3 to 6 atoms, or 3 to 10 atoms, containing at least one heteroatom. In one aspect, these groups contain 1 to 3 heteroatoms. Suitable heteroatoms include oxygen, sulfur, and nitrogen. Heterocyclic groups may be attached through a nitrogen or through a carbon atom in the ring. Suitable heterocyclic groups include pyrrolidinyl, morpholino, morpholinoethyl, and pyridyl. Such groups may be substituted.

The Applicants respectfully submit that Claims 1-2, 8-17, 19, 26, 30, 35, 37-52, 54, 61 and 65 meet the written description requirement and request withdrawal of the rejection.

### CONCLUSION

In view of the above remarks, it is believed that the application is in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

Respectfully Submitted,

Date:

7/13/04

By:

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